IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

GERARD *et al.*

Appl. No.: 09/245,025

Filed: February 5, 1999

For: **Compositions and Methods for Reverse Transcription of Nucleic Acid Molecules**

Art Unit: 1652

Examiner: Tung, P.

Atty. Docket: 0942.4330003/RWE/BJD

Reply to Requirement for Election of Species

Commissioner for Patents
Washington, D.C. 20231

Sir:

In reply to the Office Action dated December 11, 2000 (Paper No. 8), requesting an election of one species to prosecute in the above-referenced patent application, Applicants hereby provisionally elect to prosecute AMV reverse transcriptases. This election is made without prejudice to or disclaimer of the other claims or inventions disclosed.

This election is made **with** traverse. Applicants note that the various reverse transcriptases categorized by the Examiner as independent species in the present application were not so categorized in the parent case, U.S. Appl. No. 09/064,057, filed on April 22, 1998, of which the present case is a divisional application. In fact, in a restriction requirement issued in that case on December 21, 1998 (Paper No. 6), the claims under consideration in the present application were restricted into Group I. However, the Examiner in that case made no election of species requirement in connection with the claims of Group I, at least tacitly indicating that the Examiner in the parent case believed that the various reverse transcriptases could be searched simultaneously without imposing a serious burden on the Examiner.

Applicants remind the Examiner that a reasonable number of species may be claimed in different claims in a single application, provided the application includes a claim generic to all the claimed species and the claims drawn to alleged species are dependent from the generic claim(s). *See* 37 C.F.R. § 1.141(a). Moreover, when inventions are (a) species under a claimed genus and (b) related, then the question of whether or not an election of species

requirement is proper must be addressed using the criteria for determining whether or not a restriction requirement is proper; if restriction is improper under the facts of the case, an election of species requirement should not be made. *See* MPEP § 806.04(b). In the present case, the claims identified by the Examiner as reciting alleged species are all dependent from claims 1-5, 8, 9 and 22-25, which have been identified by the Examiner in Paper No. 8 as generic. Therefore, both requirements under 37 C.F.R. § 1.141(a) are met, and it must be determined whether or not restriction would be proper in the present case to determine the propriety of the election of species requirement.

The criteria for a proper restriction are that (1) the inventions must be independent or distinct as claimed; and (2) there must be a serious burden on the Examiner if restriction is not required. MPEP § 803. Applicants respectfully assert that the individual reverse transcriptases identified by the Examiner as independent species are closely related in subject matter. As such, a search of one of these alleged species is likely to encompass subject matter pertinent to the patentability of all groups, particularly since these individual reverse transcriptases and claims thereto were all classified into Class 530, subclass 350, in the restriction requirement in the parent case. Moreover, the Examiner has not satisfied the second requirement set forth in MPEP § 803, *i.e.*, the Examiner has not shown why a serious burden would be imposed on the Examiner if restriction were not required. It should be noted that the two requirements set forth in MPEP § 803 are connected with "and." Hence, satisfaction of both is required. The Examiner has not shown by appropriate explanation any of the three reasons supporting a serious burden if restriction were not required, as set forth in MPEP § 808.02. A serious burden therefore has not been established, and "[i]f the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to distinct or independent inventions." MPEP § 803. Hence, since a restriction requirement would not be proper under the facts of the present case, Applicants respectfully assert that the Election of Species requirement is improper as well under 37 C.F.R. § 1.141 and MPEP 806.04(b). Therefore, reconsideration and withdrawal of the Election of Species requirement, and consideration of all pending claims, are respectfully requested.

It is not believed that extensions of time are required, beyond those that may otherwise be provided for in accompanying documents. However, if additional extensions of time are necessary to prevent abandonment of this application, then such extensions of time are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required therefor are hereby authorized to be charged to our Deposit Account No. 19-0036.

Respectfully submitted,

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